

REMARKS

This Response is submitted in response to the Final Office Action dated July 15, 2004. Claims 1, 14, 21, 32 to 34, 38 to 40 and 46 have been amended. Claims 11, 12, 15, 16, 45, 54 and 55 stand canceled without prejudice or disclaimer. No new matter has been added.

A Request for Continued Examination and a Petition for a One Month Extension of Time to file this Response are submitted herewith. A check in the amount of \$900.00 is submitted herewith to cover the cost of the RCE and the one-month extension. Please charge deposit account number 02-1818 for any insufficiency of payment or credit any overpayment.

The Office Actions rejected Claims 1 to 10, 13, 14, 17 to 44 and 47 to 53 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office Action states that the amended claim language, "wherein the additional selection is picked before the offer associated with the first selection is displayed," does not appear to be disclosed in the specification in such a way as to reasonably convey to the Examiner that the Inventors had possession of the claimed invention. As described in more detail below, Applicants have amended certain of these claims to clarify that if a designated selection is picked, an additional selection is picked before the offer associated with the designated selection (or any of the other selections) is displayed. This subject matter is described in the specification on page 19, line 9 to page 20, line 13 and illustrated in Figures 4A and 4B.

The Office Action rejected Claims 1 to 3, 6 to 18, 21 to 23 and 25 to 55 under 35 U.S.C. §103(a) as being unpatentable over Punch-a-Bunch/The Punch Board ("PAB").

As discussed in the Response to Office Action dated April 23, 2004, PAB relates to a game show game wherein a punch board with fifty holes is provided. Value slips ranging from \$50 to \$10,000 are hidden in the fifty holes and a winnings board displays the various values that may be won by the player. In this game, the player sequentially selects a plurality of holes of the board. After the player has selected a plurality of holes, the value of the slip hidden in the first hole is offered to the player for acceptance or rejection. If the player accepts the offered value, the player is provided the offered

value and the game ends. If the player rejects the offered value, the value of the slip hidden in another one of the selected holes is offered to the player for acceptance or rejection. If the player accepts this offered value, the player is provided this offered value and the game ends. If the player rejects this offered value and the value slip of at least another one of the selected holes remains hidden, the player is enabled to select another hole. This process continues until the player accepts an offered value or all of the value slips of the selected are revealed, in which case the player is provided the last offered value.

In one version of PAB, a plurality of offer slips include "second chance" slips. In this version, the player sequentially selects a plurality of the holes and the slips hidden in the selected holes are sequentially revealed to the player. If the player selects a hole with a "second chance" slip hidden in it, the player selects an additional hole. The offer of the "second chance" slip and the offer of the additional hole are combined to form an offer which is offered to the player for acceptance or rejection as described above.

Amended independent Claim 1 is directed to a gaming device including a plurality of player selectable selections, a plurality of offers adapted to be associated with the selections and at least one display device for displaying the selections and offers to a player. The gaming device also includes a number of player picks of the selections, at least one additional player pick of the selections and a processor in communication with the display device. The processor is programmed to randomly associate the offers with said selections, wherein at least one designated selection is associated with one of said offers and said additional player pick, enable the player to sequentially select each of the number of player picks of the selections before displaying any of the offers associated the selections and enable the player to pick at least one additional selection if the designated selection is selected wherein the additional selection is picked before the offer associated with the designated selection is displayed. The processor is also programmed to sequentially display each offer associated with each selection picked by the player to the player, enable the player to sequentially accept or reject each displayed offer until the player accepts the displayed offer or until the offers associated with all of the selections picked by the player are

displayed to the player, and provide the player the displayed offer which is accepted by the player or if no displayed offer is accepted by the player, provide the player the last displayed offer.

In response to Applicants remarks in the April 23, 2004 Response to Office Action that PAB does not disclose, teach or suggest enabling the player to pick at least one additional selection if the first selection is selected, wherein the additional selection is picked before the offer associated with the first selection is displayed, the Office Action states that PAB discloses the claimed language when the additional selection is associated with the second selection. Accordingly, Applicants have amended the claim language of Claim 1 to clarify that if a designated selection is picked, an additional selection is picked before the offer associated with the designated selection is displayed. That is, if a designated selection is picked, regardless of when the designated selection is picked (i.e., as the first picked selection, the second picked selection or the third picked selection), an additional selection is picked before the offer associated with the designated selection is displayed.

Unlike the gaming device of amended independent Claim 1, PAB does not disclose, teach or suggest enabling the player pick at least one additional selection if the designated selection is selected, wherein the additional selection is picked before the offer associated with the designated selection is displayed. In PAB, for the player to be enabled to select at least one hole in addition to the originally selected holes, a "second chance" slip must be obtained. To determine if a "second chance" slip has been obtained (i.e., one of the originally selected holes has a "second chance" slip hidden in it) the "second chance" slip itself must be displayed to the player. If the slip is displayed to the player, then the offer associated with the "second chance" slip must also be displayed to the player. In other words, if a selection is associated with an additional pick of the selections (i.e., a "second chance" selection), the additional selection is picked after the offer associated with the "second chance" selection is displayed to the player.

On the other hand, in the gaming device of amended independent Claim 1, if the designated selection is picked, the player is enabled to pick the additional selection

before the offer associated with the designated selection (i.e., the "second chance" selection) is displayed to the player. In other words, in the gaming device of amended independent Claim 1, all of the picked selections are picked before any of the offers associated with the picked selections are displayed to the player, while in PAB, all of the picked selections are not picked before any of the offers associated with the picked selections are displayed to the player. Accordingly, as PAB does teach, disclose or suggest the gaming device of amended independent Claim 1, it is respectfully submitted that amended independent Claim 1 is patentably distinguished over PAB and in condition for allowance.

Claims 2, 3, 6 to 10, 13, 14, 17 and 18 depend directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Independent Claims 21, 32, 38, 44, 46 and 52, certain of which have been amended to clarify that at least one designated selection is associated with both an offer and an additional player pick and when this designated selection is picked by the player, the player is enabled to pick another selection before the offer associated with any of the picked selections are revealed to the player. On the other hand, PAB does not disclose, teach or suggest enabling the player to pick another selection when a "second chance" slip is revealed before the offer associated with the picked "second chance" selection is revealed to the player. Accordingly, for this reason and reasons given with respect to amended independent Claim 1, Applicants respectfully submit that Claims 21, 32, 38, 44, 45, 46, 52 and 54 are patentably distinguished over PAB and in condition for allowance.

Claims 22, 23, 25 to 31, 33 to 37, 39 to 43, 47 to 51 and 53 depend directly and indirectly from amended independent Claims 21, 32, 38, 44, 46 and 52, respectively, and are allowable for the reasons given with respect to these independent claims. Applicant respectfully submits that Claims 22, 23, 25 to 31, 33 to 37, 39 to 43, 47 to 51 and 53 are in condition for allowance.

The Office Action rejected Claims 4 to 5, 24 and 47 under 35 U.S.C. §103(a) as being unpatentable over PAB in view of Mayeroff.

Claims 4, 5, 24 and 47 are each directed to the gaming devices of Claim 1 (Claims 4 and 5), Claim 21 (Claim 24) or Claim 46 (Claim 47) wherein the number of player picks of the selections are either randomly determined (Claim 4), predetermined (Claims 5, 24) or both (Claim 47).

As described above, PAB relates to a selection game wherein the player picks different holes of a punchboard to obtain offers. As stated in the Office Action, Mayeroff relates to a gaming machine having a punchboard bonus game triggered by a base game wherein the number of player picks in the bonus game is dependent upon the random outcome of indices appearing on a pay line or by a predetermined number of coins that a player inputs into the base game. Accordingly, the gaming device resulting from such combination of PAB and Mayeroff would relate to a selection game wherein the player picks different holes of a punchboard to obtain offers and the number of player picks of the punchboard is dependent upon the random outcome of indices appearing on a pay line or by a predetermined number of coins that a player inputs.

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a punchboard bonus game wherein the number of picks is determined by the base game, as disclosed in Mayeroff, into a gaming machine of PAB in order to encourage players to play more lines. Applicants respectfully submit that regardless of if it would have been obvious to incorporate a punchboard bonus game wherein the number of picks is determined by the base game into a gaming machine of PAB, the gaming device resulting from the combination of PAB and Mayeroff would not disclose, teach or suggest enabling the player to pick another selection when a "second chance" slip is revealed before the offer associated with the picked "second chance" selection is revealed to the player. On the other hand, the gaming device of Claims 4, 5, 24 and 47 each provide that the player is enabled to pick any additional selections before the offer associated with any of the selections is revealed to the player. Accordingly, Applicants respectfully submit that Claims 4, 5, 24 and 47 are patentably distinguished over the combination of PAB and Mayeroff and are in condition for allowance.

The Office Action rejected Claims 17 to 20, 30, 31, 35 to 37, 41 to 43 and 51 under 35 U.S.C. §103(a) as being unpatentable over PAB in view of Mayeroff and further in view of Walker.

As described above, PAB relates to a selection game wherein the player picks different holes of a punchboard to obtain offers and Mayeroff relates to a gaming machine having a punchboard bonus game triggered by a base game wherein the number of player picks in the bonus game is dependent upon the random outcome of indices appearing on a pay line or by a predetermined number of coins that a player inputs into the base game. As stated in the Office Action, Walker relates to a gaming machine wherein the typical slot reels are altered in a matter to form a punchboard type of game that takes a combination of symbols to form an outcome that allows a player an illusion of control over the gaming machine. The Office Action concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a punchboard type of game in place of a slot reel game, as disclosed by Walker, into the gaming device resulting from the combination of PAB and Mayeroff in order to give the player an illusion of control.

Applicants respectfully submit that regardless of if it would have been obvious to incorporate a punchboard type of game in place of a slot reel game in order to give the player an illusion of control, the gaming device resulting from the combination of PAB, Mayeroff and Walker would not disclose, teach or suggest enabling the player to pick another selection when a "second chance" slip is revealed before the offer associated with the picked "second chance" selection is revealed to the player. On the other hand, the gaming device of Claims 17 to 20, 30, 31, 35 to 37, 41 to 43 and 51 each provide that the player is enabled to pick any additional selections before the offer associated with any of the selections is revealed to the player. Accordingly, Applicants respectfully submit that Claims 17 to 20, 30, 31, 35 to 37, 41 to 43 and 51 are patentably distinguished over the combination of PAB, Mayeroff and Walker and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously

solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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